

## REMARKS

Claims 28, 29, 31, 36-38 and 40, 41, 46, 52, and 54-56 are pending in the application, of which claims 38 and 40, 41, 46, 52, and 54-56 are currently under consideration. Claims 47-51 and 53 have been canceled without prejudice or disclaimer. Applicants expressly reserve the right to pursue the subject matter of those claims in one or more subsequent applications. Claim 52 has been amended. Support for the amendment to claim 52 can be found in the specification, e.g., at page 11, lines 6-9.

### Rejection under 35 U.S.C. § 103(a)

The Examiner rejected claims 38, 40, 41, and 46-56 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Pasquale EB (1991) *Cell Regulation*, 2: 523-534 (Pasquale) in view of U.S. Patent No. 4816567 (the '567 patent). Action at page 2. Specifically, the Examiner alleged that "chicken Cek5 and the instant SEQ ID NO: 11 are 95% identical, thus the skilled artisan would expect that most of the antibodies produced by raising against Cek5 would be indistinguishable from most of those obtained by raising against SEQ ID NO: 11." Action at page 2. The Examiner further alleged that "[w]hereas Pasquale teach only polyclonal antibodies . . . 4816567 teaches that in the art of antibody production, monoclonal antibodies are generally preferred to polyclonal antibodies . . . ." *Id.* at page 3.

Applicants respectfully traverse. Solely to expedite prosecution and without acquiescing to the rejection, applicants have canceled claims 47-51. Claim 38 recites "[a] monoclonal antibody or fragment thereof that binds a polypeptide consisting of

amino acids 1 to 524 of SEQ ID NO: 11.” Claims 40, 41, and 46 depend from claim 38. Claim 52 recites “[a] monoclonal antibody or fragment thereof which is raised against a polypeptide comprising amino acids 1 to 524 of SEQ ID NO: 11, wherein the antibody or fragment thereof binds the polypeptide comprising amino acids 1 to 524 of SEQ ID NO: 11.” Claims 54-56 depend from claim 52.

Applicants remind the Examiner that “the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.” MPEP 2143. The Examiner alleged that one skilled in the art “would expect that most of the antibodies produced by raising against Cek5 would be indistinguishable from most of those obtained by raising against SEQ ID NO: 11.” Action at page 2. The Examiner based that contention on his statement that that “chicken Cek5 and the instant SEQ ID NO: 11 are 95% identical.” *Id.* Yet one skilled in the art could not have known the level of identity between chicken Cek5 and amino acids 1 to 524 of SEQ ID NO: 11 prior to applicants’ own disclosure of amino acids 1 to 524 of SEQ ID NO: 11 in the present application. Without knowing the level of identity between chicken Cek5 and amino acids 1 to 524 of SEQ ID NO: 11, one skilled in the art could not have expected, as the Examiner contended, that antibodies to chicken Cek5 would bind to amino acids 1 to 524 of SEQ ID NO: 11.

Furthermore, the Examiner has not explained why one skilled in the art would have been motivated to make monoclonal antibodies to chicken Cek5 in the first place, in the absence of knowing the level of identity between chicken Cek5 and amino acids 1 to 524 of SEQ ID NO: 11. The Examiner argued only that “monoclonal antibodies are generally preferred to polyclonal antibodies.” See Action at page 3. If that preference

for monoclonal antibodies were sufficient to motivate one skilled in the art to produce monoclonal antibodies to chicken Cek5, then one skilled in the art would certainly have made those antibodies in the thirteen years since Pasquale published chicken Cek5. Yet applicants have been unable to find any reference in the literature to monoclonal antibodies to chicken Cek5. Applicants assert, therefore, that a mere “general preference” for monoclonal antibodies, without more, is not sufficient to provide motivation for one skilled in the art to make monoclonal antibodies to any particular protein. Rather, the motivation must lie, at least in part, in the value of the monoclonal antibodies themselves. In this case, the value of those antibodies is in the possibility that they may bind to amino acids 1-524 of SEQ ID NO: 11. That possibility, however, would have been unknown to one skilled in the art prior to applicants’ own disclosure in the present application. Thus, applicants assert that the Examiner’s rejection impermissibly relies on a motivation provided by the applicants’ own disclosure. The Examiner has therefore failed to present a proper *prima facie* case of obviousness.

Applicants respectfully request reconsideration and withdrawal of the rejection of claims 38, 40, 41, and 46-56 under 35 U.S.C. § 103(a).

Applicants respectfully assert that the present application is in condition for allowance and request that the Examiner issue a timely Notice of Allowance. If the Examiner does not consider the application to be allowable, the undersigned requests that, prior to taking action, the Examiner call her at (650) 849-6656 to set up an interview.

Please grant any extensions of time required to enter this Amendment and  
Response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: January 21, 2005

By: \_\_\_\_\_



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